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Paper No. 18

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**OFFICE OF PETITIONS**

In re Application of  
Bernard H. Browne, Jr.  
Application No. 09/655,792  
Filed: September 6, 2000  
Title: INSTANT MUSICIAN, RECORDING  
ARTIST AND COMPOSER

: DECISION DISMISSING  
: PETITIONS  
:  
:

This is a decision on the petition filed August 12, 2002 to revive the above-identified application under either 37 CFR 1.137(a) or under 37 CFR 1.137(b).

The above-identified application became abandoned for failure to timely file a proper reply to the final Office action mailed October 4, 2001. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). On January 15, 2002, applicant replied with an amendment. However, the amendment was determined by the examiner not to place the application in condition for allowance (Advisory Action mailed February 13, 2002). It is acknowledged that petitioner submitted the fee for a one-month extension of time on January 15, 2002. However, on May 3, 2002, applicant responded with another amendment, but did not further extend the period for reply. This amendment was not considered by the examiner because it was not timely filed. No proper reply having been timely received and no further extensions of time obtained, the application became abandoned effective February 5, 2002. A Notice of Abandonment was mailed on May 3, 2002.

Petitioner maintains that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unavoidable. *Pro se* applicant Browne appears to be making the following arguments to show unavoidable delay:

1. Applicant believed the Advisory Action mailed February 13, 2002, which stated that the period for reply expires 3 months from the mailing date of the Final Rejection, set a new period for reply because it was mailed more than 3 months after the Final Rejection. Thus, petitioner thought the filing of their response on May 3, 2002 was timely (Para. 2.3.1-2.3.2);
2. An additional three months from the mailing date of the Advisory Action was needed to comply with the action, as the action required applicant to make the amendment mailed May 23, 2001 comply with the provisions of 37 CFR 1.121. This additional time is warranted as the amendment was mailed more than 3 months before the new patent rule became effective August 2001, and the amendment complied with the rules in effect when it was filed (Para. 2.3.3);
3. A telephone request for payment of a \$55 extension fee from a USPTO employee on February 8, 2002, coupled with

receipt of the Advisory Action mailed February 13, 2002 about a week later, confirmed for applicant that the period for reply ran three (3) months from the mailing date of the Advisory Action (Para. 2.3.4);

4. Response times were shortened over previous years of such mailings due to extraordinary delays during this period caused by 9/11/01 attacks on the World Trade Center and Pentagon, anthrax contamination in mail stations and Christmas mailing loads (Para. 2.3.5).

#### **STATUTES, RULES AND REGULATIONS**

35 U.S.C. §133 provides that the Commissioner may revive an application if the delay in replying to the outstanding Office action is shown to the satisfaction of the Commissioner to have been unavoidable. A grantable petition to revive an unavoidably abandoned application under 37 CFR §1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR §1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d).

The burden of showing the cause of the delay is on the person seeking to revive the application. Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. 977, 982 (D.C. Cir. 1982). This burden includes establishing that the entire delay from the due date for the reply until the filing of a grantable petition was unavoidable. Haines v. Quigg, 673 F.Supp. 314, 316-17, 5 U.S.P.Q.2d 1130, 1131-32 (N.D. Ind. 1987). Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the "reasonably prudent person standard" in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute unavoidable delay. See Haines, 673 F. Supp. At 317, 5 U.S.P.Q.2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574

(D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). (Cf. In re Decision dated February 18, 1969, 162 U.S.P.Q. 383 (Comm'r Pat. 1969; interpretation of rule 7 was not unreasonable; hence, resultant delay in prosecution may be considered unavoidable). Furthermore, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

One who cannot show unavoidable delay is not precluded from obtaining relief by filing a petition pursuant to 37 CFR § 1.137(b) on the basis of unintentional delay. A grantable petition under § 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR §1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d).

#### ANALYSIS

Petitioner has neither made an adequate showing of unavoidable delay nor submitted the required reply, within the meaning of § 1.137(a). The explanations set forth by petitioner for the delay in replying reflect a misunderstanding of the patent rules. The rules make clear that an advisory action cannot extend the period for reply to an outstanding final rejection. The period for reply to a final rejection is set by statute to extend for a maximum of six months. As a statutory requirement cannot be waived, in no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of a final rejection. See 35 USC 37 CFR 1.136(a); MPEP 706.07(f). Had applicant understood these rules, the telephone call from the USPTO would not have further confused him.

Furthermore, petitioner's misapplication of the rules is not reasonable given the clear language of the advisory action. Under the heading "PERIOD FOR REPLY" the advisory action stated that "the period for reply expires 3 months from the mailing date of the final rejection," not 3 months from the mailing date of the advisory action. Curiously, petitioner cites on petition this very language. This again reflects his lack of knowledge of the patent rules and his confusion regarding the distinction between a final rejection and an advisory action.

Petitioner is also inaccurate in his conclusion that 37 CFR 1.121 was effective August 2001. Rather, August 2001 was the month in which a revised edition of the MPEP was published. The revision to the rule was set forth in the Federal Register on September 8, 2000, and became effective November 7, 2000. [revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]. Thus, an additional period for reply was not warranted. The amendment when filed should have been in compliance with 37 CFR 1.121.

Regarding his argument that the response time was shortened due to various extraordinary events, this argument is also not well taken. Of course, the Office is cognizant of the delays attributable to the events of September 11, 2001, as well as, those related to the anthrax contamination. The Office has set forth many new policies to account for these delays. Many of which were specifically directed to pro se applicants. However, petitioner has not shown that his delay is explained by these

extraordinary events. First of all, petitioner acknowledges as a cause of the delay his misunderstanding of the date of expiration of the response period. Secondly, petitioner does not establish a nexus between his delay and the extraordinary events of 2001. Petitioner does not show how these events caused a delay in filing a reply. Petitioner does not show that the October 4, 2001 Office action was received with less than a month remaining in the period for reply due to delays in mailing.

Petitioner's arguments and evidence have been considered, and it is concluded that petitioner has not met his burden of showing that the delay was unavoidable.

In addition, on petition, petitioner notes the amendment previously submitted May 3, 2002, as his reply under § 1.137(a)(3). A proper reply to a final Office action required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law), (2) an amendment that *prima facie* places the application in condition for allowance, (3) the filing of a continuing application, (4) a request for continuing examination under § 1.114, or (5) if applicable, a § 1.129(a) submission. The previously submitted amendment has been determined by the examiner not to place the application in condition for allowance.

Accordingly, it is concluded that a proper reply is still required to satisfy § 1.137(a).

Petitioner has also requested revival under § 1.137(b). The standard for showing that the delay was unintentional under § 1.137(b) is less exacting. Petitioner has included a statement of unintentional delay which satisfies this requirement. In addition, petitioner has paid the petition fee for consideration under § 1.137(b). As this utility application was filed after June 8, 1995, no terminal disclaimer is required. Nonetheless, the petition is not grantable under § 1.137(b). Revival under § 1.137(b) also requires submission of a proper reply to the final Office action, as described above. As petitioner has not submitted this reply, the petition under § 1.137(b) must also be dismissed.

#### CONCLUSION

The petition under § 1.137(a) is **DISMISSED**.

The petition under § 1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time under § 1.136(a) are permitted. The time period set in this dismissal of **two months for reply** with extensions of time obtainable under § 1.136(a) applies to requests for reconsideration filed under either § 1.137(a) or § 1.137(b). Regardless, petitioner should not delay filing a request for reconsideration as petitioner continues to bear the burden of establishing that the entire delay, including the delay from the due date for the reply until the filing of a grantable petition, was unavoidable or unintentional.

Further correspondence with respect to this matter should be addressed as follows:

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